

In response to subject Office Action, Applicant has submitted new formal drawing figures, in duplicate, as originally filed herein on December 18, 1997. A substitute specification was also filed herein on December 18, 1997. As indicated in Applicant's Amendment filed concurrently therewith, Applicant has conformed the specification to the drawing figures and vice-versa. Thus in view of the Examiner's request in the present Office Action that the indication for changes in the drawing figures be added to the specification, Applicant respectfully states that such has been effected by the formal figures and substitute specification originally filed herein on December 18, 1997. In that regard, Applicant kindly directs the Examiner's attention to pages 4 and 12 of Applicant's December 18, 1997 Amendment.

The substitute specification filed herein on December 18, 1997 included pages 1-270, with the new Abstract appearing on page 270. Pages 1, 269, and 270 are attached hereto as Exhibit A. In the interests of having the proper specification printed for issuance, Applicant respectfully requests that the Examiner verify that the specification entered herein is the substitute specification of December 18, 1997 by comparison thereof with the sample pages of Exhibit A.

II. Double Patenting Rejections

The Examiner provisionally rejected claims 1 and 17-71 under the judicially created doctrine of double patenting as being unpatentable over claims 1-16 in U.S. Patent No. 5,677,899.

Applicant respectability disagrees with the Examiner's double patenting rejection. Applicant believes that claims 1 and 17-71, pending herein, are patentably distinct from the subject matter pending in U.S. Patent No. 5,677,899.

The Examiner indicated that the claimed subject matter in the instant

application is fully disclosed in the referenced U.S. patent and that the subject matter claimed herein is covered by the patent because the patent and application are claiming "common" subject matter. Applicant respectfully disagrees with the Examiner in this regard for the reasons stated below.

Firstly, the test for double patenting under the judicially created doctrine of double patenting is not whether the claimed subject matter in the two cases is "common" subject matter, but whether the claimed subject matter in the case under examination is an obvious variation of the subject matter **claimed** in the commonly owned patent or copending application. M.P.E.P. 804 II. B. 1, pg. 800-17 (July 1998).

The claims pending herein are directed to methods and control apparatus for moving a carriage assembly from initial position to target position and optical disc systems including such control apparatus or operated according to such methods, while the claimed subject matter pending in U.S. Patent No. 5,677,899 is not directed to that same subject matter. Claims 1-16 in U.S. Patent No. 5,677,899 are directed only to methods for moving a carriage assembly from an initial position to a target position relative to a storage medium having a center and a circumference, and rotating relative to the carriage assembly at a circumferential velocity about the center, which Applicant believes is patentably distinct from the subject matter claimed herein.

The Examiner further indicated that there is no apparent reason why Applicant would have been prevented from presenting the claims of the instant application in the issued patent. Applicant respectfully disagrees with the Examiner's comments because, under 37 C.F.R. Sections 1.51, 1.53(b), 1.53(d), and prior Section 1.60, an Applicant is/was entitled to file continuation or divisional applications to pursue patentably distinct subject matter originally disclosed in a duly filed parent application. Since Applicant believes that the claims pending herein and those in U.S. Patent No. 5,677,899 recite patentably

distinct subject matter, all of the claims from these two cases do not belong in one application pursuant to 35 U.S.C. §§ 101, 121, and 37 C.F.R. § 1.141.

In support of the Examiner's position that there is no apparent reason why Applicant would have been prevented from presenting the claims of the instant application in the issued patent, the Examiner relies on *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). Applicant respectfully disagrees with the Examiner's reliance on the *In re Schneller* case.

Applicant understands from the content of the subject Office Action, that the Examiner is applying the "nonobvious-type" double patenting analysis of *In re Schneller*, which is also set forth in M.P.E.P. 804 II. B. 2, pgs. 800-21 et seq. (July 1998). Applicant respectfully disagrees with this rejection, and contends that *Schneller*-type (nonobvious-type) double patenting is an improper basis for rejection and contrary to law for the reasons summarized below.

Firstly, the Court of Customs and Patent Appeals ("CCPA") overruled *In re Schneller* when it made a "restatement of the law of double patenting" in *In re Vogel and Vogel*, 164 USPQ 619 (CCPA 1970). Because the CCPA always sat *en banc*, a later issued decision such as *Vogel* overrules prior decisions such as *Schneller* to the extent that the decisions are inconsistent. The *Vogel* test turns on whether a later-examined invention is distinct from a previously-patented invention. *Schneller* is inconsistent with *Vogel*, because *Schneller* omits any test for distinctness of a later-examined invention and thereby may lead to inconsistent results. Furthermore, the Federal Circuit has expressly disavowed any third kind of double patenting beyond *Vogel*'s "same-invention-type" and "obvious-type" double patenting. See *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 USPQ2d 1839, 1843 (Fed. Cir. 1992), wherein Judge Rich stated:

Clearly the two patents do not claim the *same* invention, and this is not argued. Under an obviousness-type double patenting analysis, neither *claimed* process is a mere obvious variation of the other. No other kind of "double patenting" is recognized, so there is no double patenting.

The Federal Circuit correctly stated in *General Foods* that, "No other kind of 'double patenting' is recognized," *id.* at 1839, because *Vogel* overruled *Schneller*, and left only the two *Vogel* tests ("same-invention" and "obvious" types) for double patenting.

Secondly, the Federal Circuit further rejected the underlying analysis of *Schneller* in *In re Kaplan*, 229 USPQ 678 (Fed. Cir. 1986). With due respect to the commentary published in M.P.E.P. 804 II. B. 2, at 800-21, *Kaplan* is controlling authority over *Schneller* even though *Kaplan* was decided by a three-judge panel. As discussed above, the CCPA overruled *Schneller*; therefore, *Kaplan* did not conflict with governing precedent.

III. Concluding Matters

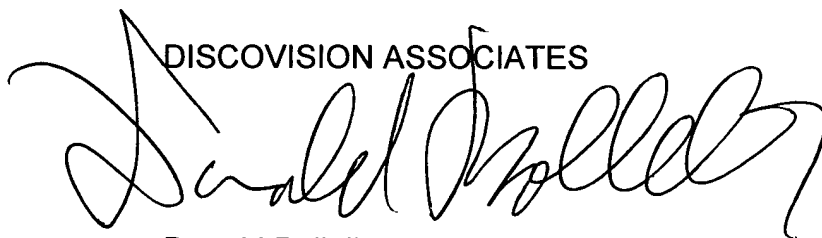
Notwithstanding Applicant's belief regarding the above, Applicant submits concurrently herewith a Terminal Disclaimer, pursuant to 37 C.F.R. 1.321(c) to obviate the double patenting rejection, in the interests of having this application issue in due course. A certificate under 37 C.F.R. 3.73(b) is filed concurrently herewith under separate cover.

In view of the Terminal Disclaimer concurrently filed herein and the foregoing remarks, Applicant believes that this application, which includes claims 1 and 17-71, is in full compliance with the Statute and Regulations. Every effort has been made to place this application in condition for allowance. Thus, early dispatch of a duly issued Notice of Allowance is earnestly requested.

If the Examiner believes that contact with Applicant's attorney would be advantageous toward the disposition of this case, he is herein requested to call Applicant's attorney at the phone number noted below.

Respectfully submitted,

DISCOVISION ASSOCIATES



Date: October 25, 1999

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